REMARKS

In the Office Action mailed May 30, 2006, the Examiner rejected claim 1 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, and 7 of copending U.S. Patent Application No. 10/697,433; rejected claims 1, 6, and 8 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 5, 9, 11, 21, and 22 of copending U.S. Patent Application No. 10/697,431; rejected claim 1 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending U.S. Patent Application No. 10/522,526; objected to claim 2 for a minor informality; rejected claim 7 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as his invention; rejected claim 10 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter; rejected claims 1-7 and 9-10 under 35 U.S.C. § 102(b) as being anticipated by Bajpai (WO 97/15009); rejected claims 8 and 11 under 35 U.S.C. § 103(a) over Bajpai in view of Aslanian et al. (U.S. Patent No. 5,111,384); and rejected claims 12 and 13 under 35 U.S.C. § 103(a) over Bajpai in view of Aslanian et al. and further in view of Cha et al. (WO 01/18652 A1).

By this Amendment, Applicant has amended claims 1, 3, 5-7, 9, and 10, and added new claim 14. Support for these changes may be found in the specification at, for example, paragraphs 038, 039, 040, 048, 052, 105, 113, and 122. In addition, Applicant has cancelled claims 2 and 11. In view of these amendments, claims 1, 3-10, and 12-14 are pending in this application.

I.   **Nonstatutory Double Patenting Rejection**

Although Applicant respectfully traverses the rejection of claim 1 on the ground of

nonstatutory double patenting over claims 1, 4, and 7 of copending U.S. Patent

Application No. 10/697,433; the rejection of claims 1, 6, and 8 over claims 1, 2, 5, 9, 11,

21 and 22 of copending U.S. Patent Application No. 10/697,431; and the rejection of

claim 1 over claim 1 of copending U.S. Patent Application No. 10/522,526, in an effort to

expedite prosecution in this case, Applicant will submit a Terminal Disclaimer upon the

Examiner's removal of the prior art rejections and indication of allowable claims in this

application. Therefore, Applicant requests that the nonstatutory double patenting

rejection of claims 1, 6, and 8 be held in abeyance until such time.

II.   **Rejection of Claim 7 Under 35 U.S.C. § 112, second paragraph**

With regard to the 35 U.S.C. § 112, second paragraph, rejection, Applicant has

amended claim 7 to recite "first and second auxiliary systems." Therefore, Applicant

requests that the rejection of claim 7 be withdrawn.

III.   **Rejection of Claim 10 Under 35 U.S.C. § 101**

Although Applicant respectfully traverses the 35 U.S.C. § 101 rejection of claim

10, in order to expedite prosecution, Applicant has amended claim 10 to recite a

"computer program product stored in a computer-readable medium." Therefore

Applicant requests the Examiner to withdraw the 35 U.S.C. § 101 rejection of claim 10.

IV.   **Rejection of Claims 1-7 and 9-10 Under 35 U.S.C. § 102(b)**

In order for Bajpai to anticipate Applicant's claimed invention under 35 U.S.C.

§ 102(b), each and every element of the claim at issue must be found, either expressly

described or under principles of inherency, in the reference. Further, "[t]he identical

invention must be shown in as complete detail as is contained in the . . . claim."

See M.P.E.P. § 2131 (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236,

9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)). Bajpai fails to anticipate claim 1 because

Bajpai does not to disclose, expressly or otherwise, each and every feature recited in

claim 1.

As amended, claim 1 recites, *inter alia*, "wherein the first and second main

systems have first and second auxiliary systems, respectively, with auxiliary knowledge

representations to evaluate problems in at least one of the first or second main systems

and to escalate problem evaluation to the service system."

Bajpai is directed to a system for remote diagnostic of a computer. (Bajpai,

Abstract.) The system determines the status of the computer and diagnoses a first set

of problems. (Bajpai, p. 5, ll. 1-3.) Once the problems are identified, an expert system

applies "conventional expert system techniques" using information regarding problems

and solutions in a database to "diagnose" the problems. (Bajpai, p. 5, ll. 18-20.) The

"expert system 30 operates using a search engine utilizing conventional expert system

techniques, such as, decision trees, case-based reasoning, pattern matching or

decision theoretic." (Bajpai, p. 6, ll. 11-12.)

Bajpai, however, does not include "first and second auxiliary systems . . . with

auxiliary knowledge representations to evaluate problems in at least one of the first or

second main systems and to escalate problem evaluation to the service system," as

recited in claim 1. The Examiner cites Figures 1 and 2, and page 6, lines 22-24, of

Bajpai for a teaching of the claimed "first and second auxiliary systems." The cited

passages, however, merely describe how the expert system maintains six problem-

solution databases as well as a generic knowledge base. (Bajpai, p. 6, ll. 19-24.) The problem-solution databases in Bajpai are located with the expert system, which is a part of the local diagnostic module 28 (the alleged service system). (Bajpai, Fig. 2.) These problem-solution databases are not located in "first and second auxiliary systems," as recited in claim 1. Furthermore, the problem-solution databases merely contain "the decision graph which is executed by the expert system." (Bajpai, p. 6, ll. 17-18.) The problem-solution databases do not "escalate problem evaluation to the service system," as recited in claim 1. Bajpai, therefore, fails to teach or suggest "first and second auxiliary systems . . . with auxiliary knowledge representations to evaluate problems in at least one of the first or second main systems and to escalate problem evaluation to the service system," as recited in claim 1. Applicant, therefore, respectfully requests that the Examiner withdraw the rejection of independent claim 1 under 35 U.S.C § 102(b), as well as claims 3-7, at least due to their dependence from claim 1. The rejection of claim 2 is moot since the claim has been cancelled.

Independent claim 9 recites "processing the problem related data, the first set of search results and the second set of knowledge representations by the second expert system to search for the solution to identify a second set of search results." The Examiner cites page 10, lines 17-21, and page 11, lines 5-24 for a teaching of the above-recited claim limitations. (Office Action, p. 11.) Applicant disagrees. The portions of Bajpai cited by the Examiner state that the remote diagnostic element 50 (the alleged second expert system) is constructed and operated similarly to the local diagnostic element 28 (the alleged first expert system). The remote diagnostic element 50 also includes an expert system engine and problem-solution rule databases.

(Bajpai, p. 10, II. 20-21.) The expert system of the remote diagnostic element 50 can operate identically to the expert system of the local diagnostic element 28. (Bajpai, p. 10, II. 17-19.). In Bajpai, however, if the expert system in local diagnostic element 28 does not find a solution to the problem, then the local diagnostic element 28 contacts the remote diagnostic element 50. (Bajpai, p. 9, II. 19-25.) The Bajpai system passes "information to the remote diagnostic element [50]." (Bajpai, p. 9, II. 28.) Bajpai, however, does not process "problem related data, the first set of search results and the second set of knowledge representations by the second expert system to search for the solution to identify a second set of search results" at the remote diagnostic element 50 because, in the Bajpai system, the first set of search results is not passed to the remote diagnostic element 50. Therefore, Bajpai fails to teach or suggest "processing the problem related data, the first set of search results and the second set of knowledge representations by the second expert system to search for the solution to identify a second set of search results," as recited in claim 9. For at least the above reasons, the Examiner has not demonstrated that Bajpai discloses all of the elements of claim 9. Therefore, the rejection of claim 9 under 35 U.S.C. § 102(b) is improper and should be withdrawn, as well as claim 10, at least due to its dependence from claim 9.

V.   Rejection of Claims 8 and 11-13 Under 35 U.S.C. § 103(a)

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art references must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. *See* M.P.E.P. § 2143.

Here, the cited references cannot support a rejection under 35 U.S.C. § 103 because, among other things, Bajpai, Aslanian et al., or Cha et al., taken alone or in any proper combination, do not disclose, teach, or suggest each and every feature recited in Applicant's claim 1.

As noted above with regard to claim 1, Bajpai does not disclose "wherein the first and second main systems have first and second auxiliary systems, respectively, with auxiliary knowledge representations to evaluate problems in at least one of the first or second main systems and to escalate problem evaluation to the service system." Neither Aslanian et al. nor Cha et al. overcome the shortcomings of Bajpai.

The Examiner cites Aslanian et al. for its teaching of "distinguishing the main system versions." (Office Action, p. 12.) Also, Cha et al. is cited by the Examiner for the teaching of an "enterprise resource planning system" and an "R/3" system. However, neither Aslanian et al. nor Cha et al. disclose or suggest "wherein the first and second main systems have first and second auxiliary systems, respectively, with auxiliary knowledge representations to evaluate problems in at least one of the first or second main systems and to escalate problem evaluation to the service system," as recited in claim 1. Nor does the Examiner assert that Aslanian et al. or Cha et al. disclose such features.

Accordingly, Bajpai, Aslanian et al., or Cha et al., taken alone or in any proper combination, do not teach or suggest each and every feature recited in Applicant's independent claim 1 and, therefore, cannot support a rejection of these claims under

35 U.S.C. § 103(a). Dependent claims 8, and 12-13 are also allowable, at least due to their corresponding dependence from claim 1. The rejection of claim 11 is moot since the claim has been cancelled.

VI. <u>Conclusion</u>

In view of the foregoing amendments and remarks, Applicant submits that the claims are neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant, therefore, requests the Examiner's reconsideration and reexamination of the application, and the timely allowance of currently pending claims 1, 3-10, and 12-14.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: August 25, 2006   By:_____
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